



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/610,493

06/30/2003

Robert K. Hughes JR.

MS1-1444US

5381

22801 7590 02/27/2009

LEE & HAYES, PLLC
601 W. RIVERSIDE AVENUE
SUITE 1400
SPOKANE, WA 99201

EXAMINER

ZHAO, DAQUAN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/610,493	Applicant(s) HUGHES, ROBERT K.	
	Examiner DAQUAN ZHAO	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26-28, 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/8/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/8/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-24, 26-28, and 33-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8-10, 18-19, 21-24 and 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2621

Claims 8-10, 18-19, 21-24 and 26-28 are single means claims. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. **In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197** (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 11-17 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 13 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. **In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008)**; **Diamond v. Diehr, 450 U.S. 175, 184 (1981)**; **Parker v. Flook, 437 U.S. 584, 588 n.9 (1978)**; **Gottschalk v. Benson, 409 U.S. 63, 70 (1972)**; **Cochrane v. Deener, 94 U.S. 780,787-88 (1876)**.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claims 2-5, 11-12, 14-17 and 20 incorporate the same deficiency as set forth in claims 1 and 13 above.

5. Claims 9 and 26 are rejected under 35 U.S.C. 101 because claims are directed to non-patentable subject matter.

Claims 9 and 26 are directed to a "broadcast point", wherein paragraph 63 of the Patent Application Publication of the instant application describes the claimed "broadcast point" can be a "web site". Therefore, the claimed "broadcast point" can be software per se, which is non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 8-10, 18-19, 21-24 and 26-28 rejected under 35 U.S.C. 102(e) as being anticipated by Boston et al (US 2003/0,235,392 A1).

For claim 8, Boston et al teach a DVD player that implements the method of claim 7, wherein the medium is a DVD disc (paragraph 68 of Boston disclose a DVD player. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co.

v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original), see MPEP 2114).

For claim 9, Boston et al teach a broadcast point that perform the method of claim 1 (e.g. figure 2a, Content Sources 182).

For claim 10, Boston et al teaches a multimedia device that performs the method of claim 19 (e.g. figure 1a, PVR 11).

For claim 18, Boston et al teach a DVD player that implements the method of claim 17, wherein the medium is a DVD disc (paragraph 68 of Boston disclose a DVD player).

For claim 19, Boston et al teach a personal video recorder that implements the method of claim 17 (e.g. figure 1a, PVR 11).

For claim 21, Boston et al teach a DVD player that implements the method of claim 20, wherein the medium is a DVD disc (paragraph 68 of Boston disclose a DVD player).

For claim 22, Boston et al teach a personal video recorder that implements the method of claim 20 (e.g. figure 1a, PVR 11).

For claim 23, Boston et al teaches a multimedia device that performs the method of claim 13 (e.g. figure 1a, PVR 11).

For claim 24, Boston et al teaches a multimedia player that performs the method of claim 13 (e.g. figure 1a, PVR 11).

For claim 26, Boston et al teach a broadcast point that perform the method of claim 23 (e.g. figure 2a, Content Sources 182).

For claim 27, Boston et al teaches a multimedia device that performs the method of claim 23 (e.g. figure 1a, PVR 11).

For claim 28, Boston et al teaches a multimedia player that performs the method of claim 23 (e.g. figure 1a, PVR 11)

8. Claims 1 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Imahashi et al (US 2001/0,001,023 A1).

For Claim 1, Imahashi et al teach identifying multimedia elements having a single linear time-code number (e.g. abstract, paragraphs 1, 169-170, figures 13-14 and 16, each picture of the video stream corresponds to the claimed multimedia elements); adding prefix value to linear time-code numbers of each identified multimedia elements (e.g. figures 9 and 11A, LTC stands for linear time code, and "DATA ID (= LTC)" is considered to be the prefix since it comes before the LTC); and adding suffix values to the linear time-code numbers of each identified multimedia element ("DATA ID(= Ancillary Data)" is considered to be the suffix since it comes after the LTC).

For claim 33, Imahashi et al teach a multimedia device comprising: a processor (e.g. paragraph 50-51, receiver system 3 is consider to be the processor); a multimedia storage module executable on the processor and configured to store multimedia presentation content comprising of multimedia elements (e.g. figure 1, paragraph 50 and 51, video frames are stored in the VTR 40 by the receiver system 3); and an extended time-code number module executable on the processor configured to append extended time-code numbers to multimedia element without a time-code number,

Art Unit: 2621

wherein each multimedia element has a single time-code number (e.g. paragraph 51, figures 9, 11, 13, 14 and 16A, the time code in figures 1 or 11 are append on each video as shown in figures 13-14 and 16A, also see abstract, paragraphs 1, 169-170).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3, 11, 13, 14, 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1) as applied to claims 1, 11, 33 above, and further in view of Kanda (US 6,324,335 B1).

For claim 13, Imahashi et al teach a method comprising: a particular multimedia presentation content comprised of multimedia elements described by extended time-code numbers, wherein the multimedia elements have a single extended time code (e.g. figure 16A, abstract, paragraphs 1);

Imahashi et al fail to teach the title value and searching for particular multimedia elements based on their extended time-code number. Kanda teaches the title value and searching for particular multimedia elements based on their extended time-code number (e.g. column 26, lines 45-62, the CPU refers to the time code to search the recording address of the video data for reproduction, figure 8 shows the "Title" which is 16 bit). It would have been obvious to one ordinary skill in the art at the time the invention was

Art Unit: 2621

made to incorporate the teaching of Kanda into the teaching of Imahashi et al to rapidly reproduce the video data (e.g. Kanda, column 26, lines 60-63).

In regard to claim 3, Kanda teaches the prefix value comprises a title value (e.g. column 18, line 66- column 19, line 22, and figure 8, Title, which is arrange before the in-point time-code data, corresponds to the prefix value, wherein the title value has 16 bytes);

In regards to claim 17, Kanda teaches the searching is performed based on a time map table that associates multimedia elements with extended time-code number (e.g. column 26, lines 45-62, when the CPU 303 reproduces or plays back the video, the CPU 303 has to know when to look for the video data. column 26, lines 45-62 teaches the CPU 303 search for the video data according to the relation of the time code and the recording address, wherein the time code are stored in a table).

For claim 14, Imahashi et al teach the extended time code numbers compises a prefix and suffixes (e.g. figures 9 and 11A, LTC stands for linear time code, and “DATA ID (= LTC)” is considered to be the prefix since it comes before the LTC; “DATA ID(= Ancillary Data)” is considered to be the suffix since it comes after the LTC).

In regards to claim 11, Kanda teaches identifying elements without a linear time-code number, and adding a linear time-code to the identified elements without a linear time-code (e.g. column 28, lines 6-15, time code is not added video if the time code has been added. Therefore, the first time-code adding unit must have identified and added time code to the video data without time code).

Art Unit: 2621

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023) as applied to claims 1 and 33 above, and further in view of Sturgeon et al (US 6,429,879 B1).

See the teaching of Imahashi et al above.

For claim 4, et al fails to teach the suffix values comprise language value, angle value, and parental block value. Sturgeon et al teach the suffix values comprise language value, angle value, and parental block value (e.g. column 7, lines 1-27 and figure 5). It would have been obvious to one ordinary skill in the art at the time the invention was made to have incorporated the teaching of Sturgeon et al into the teaching of Imahashi et al to increase effectiveness of parental management of content presentation (Sturgeon et al, column 4, lines 1-15).

12. Claim 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023) and Kanda (US 6,324,335 B1) as applied to claims 1, 3, 11, 13, 14, 17 and 33 above, and further in view of Sturgeon et al (US 6,429,879 B1).

See the teaching of Imahashi et al and Kanda above.

For claim 16, Imahashi et al and Kanda fail to teach the suffix values comprise language value, angle value, and parental block value. Sturgeon et al teach the suffix values comprise language value, angle value, and parental block value (e.g. column 7, lines 1-27 and figure 5). It would have been obvious to one ordinary skill in the art at the time the invention was made to have incorporated the teaching of Sturgeon et al into

Art Unit: 2621

the teaching of Imahashi et al and Kanda to increase effectiveness of parental management of content presentation (Sturgeon et al, column 4, lines 1-15).

13. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1), as applied to claims 1 and 33 above, and further in view of the Prior Art section of the instant application.

See the teaching of Imahashi et al above.

Regarding claims 2 and 12, Imahashi et al fail to teach the multimedia elements comprise audio video elements and interspersed elements. The Prior Art section of the instant application teaches the multimedia elements comprise audio video elements and interspersed elements (e.g. figure 2 and page 6, lines 15-22). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of the Prior Art section of the instant application into the teaching of Imahashi et al to effectively management information from different sources.

14. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1), as applied to claims 1 and 33 above, and further in view of Yamauchi et al (US 6,336,002 B1).

See the teaching of Imahashi et al above.

For claim 5, Imahashi et al fail to teach a time map table that are associates the multimedia elements to linear time-code numbers. Yamauchi et al teach a time map table that associates the multimedia elements to linear time-code numbers (e.g. figure

Art Unit: 2621

8, VTS TIME MAP TABLE, column 14, lines 52-65 and column 37, lines 27-35). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Yamauchi et al into the teaching of Imahashi et al to include the linear time-code numbers with prefix and suffix in the time map table to allow the system to perform a chapter search or time search immediately and to immediately determine whether chapter search and time functions should be enacted or prohibited (Yamauchi et al, column 4, line 64- column 5, line 3).

For claim 7, Yamauchi et al teach the time map table is part of a file that provides pointers to data structures in a medium (e.g. figure 8, VTS TIME MAP TABLE is within the VTS MANAGEMENT TABLE, wherein the VTS management table contains Title search pointers).

15. Claims 6, 36, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1), as applied to claims 1, 33 above, and further in view of Saeki et al (US 6,078,727).

See the teaching of Imahashi et al above.

For claim 6, Kanda fails to specify the time map is used by a DVD player to point to particular sectors on a DVD disc containing content representing the multimedia elements. Saeki et al teach the time map is used by a DVD player to point to particular sectors on a DVD disc containing content representing the multimedia elements (e.g. figures 8-9, column 9, lines 26-56, the VOB position in the DVD corresponds to sector). It would have been obvious to one ordinary skill in the art at the time the invention was

Art Unit: 2621

made to incorporate the teaching of Saeki et al into the teaching of Imahashi et al to reduce the amount of optical disc reproduction information for storage efficiency (Saeki et al, column 2, lines 30-35).

For claim 36, Saeki et al teach a multimedia (e.g. figure 14).

For claim 37, Saeki et al teach a DVD player that implements the method of claim 7, and wherein the medium is a DVD disc (e.g. figure 14).

For claim 38, Saeki et al teach the multimedia device is a personal video recorder (e.g. figure 14).

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1) and kanda (US 6,324,335 B1) as applied to claims 1, 11, 33, 3, 11, 13, 14, 17 above, and further in view of Saeki et al (US 6,078,727).

For claim 20, Imahashi et al and Kanda fail to teach the time map table is part of an information file that provides navigation and presentation information for titles in a medium. Saeki et al teach the time map table is part of an information file that provides navigation and presentation information for titles in a medium (e.g. figure 8, the time map table is in the AV File management table, which is in the AV data management file, which is used for navigation and presentation). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Saeki et al into the teaching of Imahashi et al and Kanda to reduce the amount of

Art Unit: 2621

optical disc reproduction information for storage efficiency (Saeki et al, column 2, lines 30-35).

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1) and kanda (US 6,324,335 B1) as applied to claims 1, 11, 33, 3, 11, 13, 14, 17 above, and further in view of Sullivan (US 2004/0,030,665 A1).

For clam 15, Imahashi et al and Kanda fails to teach searching is performed based on the prefix and on one or more of the suffixes. Sullivan teaches searching is performed based on the prefix and on one or more of the suffixes (e.g. claim 25 of page 14). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Sullivan into the teaching of Kanda for high speed searching.

18. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imahashi et al (US 2001/0,001,023 A1) and kanda (US 6,324,335 B1), as applied to claims 1, 11, 33, 3, 11, 13, 14, 17 above, and further in view of Prior Art section of the instant application.

For claim 34, Kanda teaches multimedia player module executable on the processor and configured to play the audio/video (e.g. column 26, lines 45-63). However, Imahashi et al and Kanda fail to teach the interspersed elements. The Prior Art section of the instant application teaches interspersed elements (e.g. figure 2 and page 6, lines 15-22). It would have been obvious to one ordinary skill in the art at the

Art Unit: 2621

time the invention was made to incorporate the teaching of the Prior Art section of the instant application into the teaching of Imahashi et al and Kanda to effectively management information from different sources.

For claim 35, Kanda teach search for audio/video ememetns based on extended time-code numbers (e.g. column 26, lines 45-62, the CPU refers to the time code to search the recording address of the video data for reproduction, figure 8 shows the "Title" which is 16 bit).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daquan Zhao

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621